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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENYAHIA NASLI-BAKIR,
STEFAN LINDBERG, and
ANNA JANACKOVIC

Appeal 2010-002997
Application 09/700,747
Technology Center 1700

Before BRADLEY R. GARRIS, ADRIENE LEPIANE HANLON, and
TERRY J. OWENS, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

A. STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from an Examiner's decision finally rejecting claims 39, 41-46, 56-76, and 78-98. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The subject matter on appeal relates to a method of separately applying resin and hardener components of an amino resin gluing system onto a substrate of a gluelam or laminated timber. Claim 39, reproduced below, is illustrative.

39. A method of applying an amino resin gluing system to a substrate of a gluelam or laminated timber, comprising the steps of:

(a) feeding an amino resin component selected from the group consisting of melamine-formaldehyde and melamine-urea-formaldehyde to at least a first orifice;

(b) feeding a hardener component to at least a second orifice; and

(c) discharging said resin and hardener components through said respective first and second orifices in the form of strands onto the substrate, said discharged components remaining physically isolated from each other until at least one of said components contacts said substrate;

wherein the hardener comprises a volatile acid and is either free from filler or includes filler in an amount of less than 20% by weight.

App. Br., Claims Appendix.²

² Appeal Brief dated June 19, 2009.

The following Examiner's rejections are before us on appeal:³

(1) Claims 39, 41-45, 56-59, 70-76, 78-82, 84-87, 89-93, 95, and 98 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Andersson⁴ and Lehnert.⁵

(2) Claims 46, 83, 88, 96, and 97 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Andersson, Lehnert, and Perciwall.⁶

(3) Claims 60-64 and 66-69 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Andersson, Lehnert, and Toshio.⁷

(4) Claim 65 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Andersson, Lehnert, Toshio, and Perciwall.

(5) Claim 94 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Andersson, Lehnert, and Perciwall.

(6) Claims 70 and 76 are rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1, 9, and 18 of US 6,734,275 B2 in view of Andersson.

(7) Claim 94 is rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1, 9, and 18 of US 6,734,275 B2 in view of Perciwall and Andersson.

³ The Examiner finally rejected claims 40 and 77 under 35 U.S.C. § 103(a). See Final Office Action dated August 14, 2008, at 5; Examiner's Answer dated September 25, 2009 ("Ans."), at 7. Claims 40 and 77 have been cancelled. Therefore, this rejection is dismissed as moot. See App. Br. 13.

⁴ EP 0 207 024 A2, published December 30, 1986.

⁵ WO 89/05221, published June 15, 1989.

⁶ EP 0 016 740 A1, published October 1, 1980.

⁷ JP 61-040137, published February 26, 1986.

The Appellants address the claims in each of rejections (1), (2), and (5)-(7) as a group and present the same arguments for each ground of rejection.⁸ Therefore, for purposes of this appeal, the patentability of the claims in rejection (1) will stand or fall with the patentability of claim 39 and the patentability of the claims in rejections (2) and (5)-(7) will be based on the arguments set forth in support of the patentability of claim 39. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2010).

As for rejection (3), the Appellants address the claims in this rejection as a group and present the same arguments for both rejections (3) and (4). App. Br. 13. Thus, for purposes of this appeal, the patentability of the claims in rejection (3) will stand or fall with the patentability of claim 60 and the patentability of claim 65 in rejection (4) will be based on the arguments advanced in support of the patentability of claim 60.

B. ISSUE

Have the Appellants identified reversible error in the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art to separately apply the resin and hardener components of the amino adhesive system disclosed in Lehnert in view of the teachings in Andersson?

⁸ For example, with respect to the nonstatutory obviousness-type double patenting rejection over claims 1, 9, and 18 of US 6,734,275 B2 in view of Andersson, the Appellants state “[f]or the same reasons as the obviousness rejection over Andersson in view of Lehnert is improper[,] this rejection for non-statutory obviousness type double patenting is improper for failing to provide a showing of *prima facie* obviousness.” App. Br. 14; *see also* App. Br. 15-16. We note that claim 1 of US 6,734,275 B2 is directed to a method of gluing wood based materials including the step of separately applying an amino resin and a hardener composition. *See* Ans. 13.

C. FINDINGS OF FACT

The Appellants disclose that separate application of components of a gluing system onto a substrate, such as a piece of wood, is known in the art. The Appellants disclose that keeping the resin and hardener components separated in an application device results in many known advantages, such as pot life, operation, and cleaning. Spec. 1:10-16.

The Appellants also disclose that separate application of the components of amino resin gluing systems to wooden parts is suggested in EP 0 362 742 and WO 97/29161. Spec. 1:17-26; *see also* Reply Br. 7.⁹

The invention disclosed in Andersson is directed to producing laminated wood using curable adhesives whereby resin and hardener components are separately applied to a wood surface. Andersson 1:4-8.

Andersson discloses that separately applying resin and hardener components has a number of advantages, such as eliminating a mixing operation before application, eliminating the risk of pre-curing an adhesive mix at storage, transport and in application equipment, and avoiding operation interruptions due to these factors. Andersson discloses that separate application also means that pot-life or working life of the components is, in theory, unlimited, the need to clean equipment after use is eliminated, and the need to discard adhesive which has not been used is eliminated. According to Andersson, these advantages have been known for a long time and have been used in several known bonding methods, particularly in highly industrialized gluing processes, such as lamination processes. Andersson 1:9-26.

⁹ Reply Brief dated November 25, 2009.

Andersson discloses that despite the advantages known in the prior art, an uneven distribution of the adhesive components on a wood surface can cause unreacted liquid component to be dissolved and flow out from a glue joint when it rains causing “bleeding from the joint” or dark stains on the wood surface. Andersson 1:34-39.

According to Andersson, the object of the disclosed invention is to solve the problem of bleeding from joints that have been glued using conventional formaldehyde based adhesives, preferably resorcinol-formaldehyde adhesives or resorcinol-phenolformaldehyde adhesives, by using a resin component having limited water dilutability. Andersson 2:5-11.

The invention disclosed in Lehnert relates to a method for producing wood products, such as plywood. Lehnert 1:2-4.

Lehnert discloses that “adhesives used in the manufacture of plywood are usually phenol resins (condensation products of phenol and formaldehyde) and amino resins (condensation products of formaldehyde and urea and/or melamine).” Lehnert 1:28-31.

D. DISCUSSION

1. Claim 39

The Examiner found that Andersson does not disclose a gluing system comprising an amino resin component. Ans. 3. Instead, Andersson discloses conventional gluing systems comprising a phenol resin component. *See, e.g.*, Andersson 2:5-11. The Examiner relies on Lehnert to establish that phenol resins as well as amino resins are conventionally used in two-component adhesive systems to produce laminated wood products. Ans. 3-4; Ans. 20 (“both phenolic and amino systems are suitable to join wood”).

The Examiner concludes that “it would have been obvious to one of ordinary skill in the art to modify the process of Andersson by substituting, as the gluing system, the amino resin gluing system of Lehnert.” Ans. 4. In other words, it would have been obvious to one of ordinary skill in the art to separately apply the resin and hardener components of the gluing system disclosed in Lehnert in view of the advantages of separate application disclosed in Andersson. Ans. 19. The Examiner concludes that “[o]ne of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully joining wooden surfaces to form a laminate.” Ans. 4.

The Appellants argue that the proposed modification would render the Andersson disclosure totally meaningless. In particular, the Appellants argue that Andersson is directed to specific conditions for producing certain resorcinol adhesives. The Appellants argue that “[b]y substituting an amino resin for the resorcinol-based resin in Andersson, the entire teaching of specific reaction conditions in the Andersson reference must be ignored, since they are specific to resorcinol and cannot be applied to amino resins.” App. Br. 10. The Appellants also argue that Andersson teaches away from using the conventional amino resins disclosed in Lehnert because Andersson is interested in using a resin component that has limited water dilutability and the resins disclosed in Lehnert are readily dilutable in water.¹⁰ App. Br. 11.

¹⁰ The Appellants also argue that the amino resins in Lehnert have an acid hardener and acid conditions are contrary to the teachings in Andersson. App. Br. 11; Reply Br. 9. Notably, the disclosure in Andersson relates to the resin component, not the hardener component. *See* Andersson 2:16-26.

The Appellants' arguments misconstrue the Examiner's position. The Examiner is not proposing to substitute the amino resin component of the Lehnert adhesive system for the phenol resin component in the adhesive system of Andersson. Rather, the Examiner is relying on Andersson to establish that it was known to separately apply the resin and hardener components in conventional two-component adhesive systems to produce laminated wood products. Based on the teachings in Andersson, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to separately apply the resin and hardener components of the Lehnert adhesive system onto a wood substrate. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

Significantly, the Appellants do not establish, either by way of argument or evidence, that separate application of the resin and hardener components of the Lehnert adhesive system would render the adhesive system unsuitable for its intended purpose. Likewise, the Appellants do not establish, either by way of argument or evidence, that separately applying the components of the Lehnert adhesive system would not result in the same advantages disclosed in Andersson (e.g., pot life, operation, cleaning).

We recognize that Andersson discloses that an uneven distribution of adhesive components may cause "bleeding from the joint" in a rainy environment. Andersson 1:34-39. However, there is no evidence on this record that the amino resins disclosed in Lehnert would suffer from this same deficiency. Moreover, the disadvantage disclosed in Andersson cannot be said to outweigh the obviousness of the Examiner's proposed

combination because Lehnert does not limit the use of the disclosed wood products to a rainy environment. In sum, there is no evidence on this record establishing that any disadvantages in separately applying the resin and hardener components of the Lehnert adhesive system would outweigh the advantages identified in Andersson.

Finally, the Appellants argue that the claimed method provides unexpectedly improved delamination. The Appellants attribute the alleged unexpected results to the amount of filler, not to the separate application of the resin and hardener components. The Appellants rely on Example 1 in the Specification for support. App. Br. 12.

We recognize that Example 1 shows that the percentage of delamination decreases as the amount of filler decreases. However, the Examiner points out that the showing in Example 1 is not commensurate in scope with the claims. That is, the showing is limited to a melamine-urea-formaldehyde resin component and the claims on appeal encompass at least melamine-urea-formaldehyde *and* melamine-formaldehyde resin components. Ans. 21.

In the Reply Brief, the Appellants recognize as much. Nonetheless, the Appellants argue that “one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof also to melamine-formaldehyde and ‘amino resin gluing system’ in general.” Reply Br. 10. Suffice it to say that there is no evidence on this record indentifying the “trend” referred to by the Appellants. *See In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (“Argument in the brief does not take the place of evidence in the record.”).

In addition, the Appellants have failed to direct us to any evidence establishing that the results reported in Example 1 are “unexpected.” As explained in *In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973), in order for a showing of “unexpected results” to be probative evidence of non-obviousness, an applicant must establish that the difference between the results obtained through the claimed invention and the prior art would not have been expected by one skilled in the art at the time of invention.

For the reasons set forth above, the preponderance of the evidence supports the Examiner’s conclusion of obviousness. Therefore, the § 103(a) rejection of claim 39 will be affirmed.

2. Claim 60

The Examiner finds that neither Andersson nor Lehnert teaches discharging adhesive components as recited in claim 60. However, the Examiner finds that Toshio teaches applying adhesive components in strands from hollow members each having a plurality of orifices as recited in claim 60. Ans. 7-8. The Examiner concludes that “[i]t would have been obvious to one skilled in the art . . . to modify the process of Andersson in view of Lehnert so as to utilize the hollow application members of Toshio.” Ans. 8.

The Appellants argue that “the Examiner has failed to explain the inconsistency of Toshio’s separate strand application of components with Lehnert’s required mixing of components.” App. Br. 13.

The Appellants’ argument fails to consider the prior art as a whole. The Examiner relies on Andersson to establish that one of ordinary skill in the art would have separately applied the resin and hardener components of the Lehnert adhesive system to produce a laminated wood product. For the reasons discussed above, the Appellants have failed to demonstrate any error

in the Examiner's position. Thus, the § 103(a) rejection of claim 60 will be affirmed.

E. DECISION

For the reasons set forth above and in the Examiner's Answer, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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